

REMARKS

Summary

Claims 25-37 were pending and all of the claims were rejected in the present Office action. Claims 25, 32, 34 and 36 have been amended. The Specification has been amended to include a priority claim which has been previously asserted and acknowledged. No new matter has been added. The Applicants respectfully submit that the amendments place the application in condition for allowance.

Claim Rejections

35 U.S.C. § 112, second paragraph

Claims 36 and 37 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Applicants call attention to the use of the two sub-clauses in the alternative, and have amended Claim 36 to emphasize that fact. As such, there is no ambiguity and the Applicants respectfully submit that the rejection has been overcome.

35 U.S.C. § 103 (a)

Claims 25-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yoshikawa et al. (US 6,132,892; "Yoshikawa") in view of either Anderson et al. (US 4,661,216; "Anderson") or Omata (US 5,011,581; "Omata") and further in view of Lee et al. (US 6,346,181; "Lee") and the article entitled "Plating with Pulsed and Period-Reverse Current" by Sun et al. ("Sun"). A copy of the Sun reference has been furnished by the Examiner. The Applicants respectfully submit that the Examiner has not made out a *prima facie* case of obviousness. However, the Applicants have taken the opportunity to amend Claim 1 so as to clarify the details of the method.

Yoshikawa is cited to illustrate a soft magnetic film having a composition which the Examiner states overlaps the ranges of Claim 25. However, Yoshikawa does not teach a method of manufacturing (a process) involving solution plating. Anderson is cited as teaching a plating method of forming a high cobalt magnetic film (Anderson,

Abstract), and the ternary diagram of Fig. 1 illustrates both prior art and the range of compositions termed "high cobalt". It may be seen that the Co component is in the range approximately 70-83%, the Fe component is in the range approximately 15-25% and the Ni component is in the range approximately 5-18%. These ranges for the Co and Fe components do not overlap with the ranges of Claim 25, and therefore the teachings of Anderson would not lead a person skilled in the art to use the plating solutions taught by Anderson to achieve the result taught by Yoshikawa, particularly as Anderson specifically points out that a high cobalt percentage is the result of the process (Anderson, col 2, lines 7-14). Yoshikawa, while teaching certain values of material properties, does not teach a solution-plating method, and cannot be used as a method teaching in this circumstance.

A method teaching cannot be applied in an anticipation rejection of an apparatus claim. (Carnegie Steel Co. v. Cambria Iron Co., 185 U.S. 403, 324 (1902) "In other words, a process patent can only be anticipated by a similar process".) It thus follows that an apparatus teaching cannot be used to support a rejection of a method claim, in either an anticipation or a 102/103 rejection.

With respect to Omata as a reference, it too is a method patent, and the method taught results in a substantially different Fe component range than that of the present Claim 25.

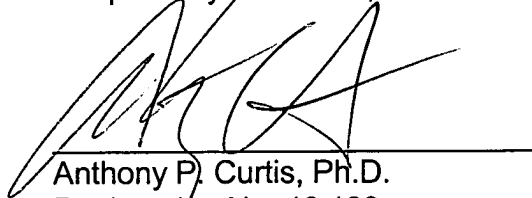
For at least the reasons given above, there is no teaching or suggestion to combine the teachings of the references nor do the references which may be properly applied teach all of the steps and limitations of the method; therefore, a *prima facie* case of obviousness has not been made out and Claim 25 is allowable. Claims 26 -37 are claims that are either dependent on Claim 25 or incorporate the subject matter of Claim 25 and are thus also allowable.

Conclusion

Claim 25-37 are pending. Claims 25, 32, 34 and 36, and the specification, have been amended.

The Applicants respectfully submit that the application is in condition for allowance. The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'APC', is written over a horizontal line.

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